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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/041,835

10/25/2001

Jay S. Dweck

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04/21/2006

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EXAMINER

DENNISON, JERRY B

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,835

Applicant(s)

DWECK, JAY S.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10, 12-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/25/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to Application Number 10/041,835 received on 23 January 2006.
2. Claims 1-4, 6-10, 12-16, and 18-21 are presented for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 19 is directed to a computer-readable medium that stores data accessible by a program to perform a method, in which the computer-readable medium may be directed towards non-tangible embodiments (see Specification, page 14 last paragraph), and is therefore not tangibly embodied in a manner so as to be executable and is thus non-statutory for failing to be in one of the categories of invention.
4. The computer readable medium must be a physical structure, not a signal, which permits the functionality to be realized with the computer.
5. Applicant is respectfully requested to amend the specification to include separate categories of a "computer readable medium", the categories including hardware mediums (CD-ROM, DVD-ROM, zip disk, magnetic tape) and non-hardware mediums (signal), and also amend claim 19 to include **only** the hardware mediums. Applicant is suggested not to simply delete references to a "signal", as this would include new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of what is well known in the art.

6. Regarding claims 1, 9, 13, 15, 20, and 21, AAPA disclosed a network communication method, comprising:

identifying, for a communication session, an originator and a participant;

establishing, by said originator, a reciprocity rule for said communication session;

and

conducting said communication session involving said originator and said participant based on said reciprocity rule (AAPA, Spec, page 2, AAPA admitted IM services offered by America Online in which a session is started between a sender and intended recipients using reciprocal communication).

AAPA did not explicitly state wherein the originator established the reciprocity rule, governing an ability of said participant to send a message to said originator, wherein said reciprocity rule prevents said participant from sending a response message to said originator.

As shown in the last Office Action, Examiner takes Official Notice (see MPEP § 2144.03) that "permitting or blocking recipients in responding to the originator" in an instant messaging environment was well known in the art at the time the invention was made (see previous Office Action, Official Notice taken).

Claim 9 includes a communication device including limitations that are substantially similar to those of claim 1, and are therefore rejected under the same reasoning. Claim 13 further includes a communications port in order to communicate with a messaging server or a participant. It is inherent that the sending device of a sender using America Online includes a port to provide communication to the America Online Server as well as a participant and therefore claim 13 is also rejected under the same reasoning as claim 1. Claim 15 includes a messaging system including limitations that are substantially similar to those of claim 1, and are therefore rejected under the same reasoning.

7. Regarding claim 2, AAPA disclosed the limitations, substantially as claimed, as described in claim 1, including wherein said identifying further comprises identifying a plurality of participants and wherein said conducting further comprises involving said plurality of participants (AAPA, Spec, page 2, AAPA admitted users of America Online having a chat rooms in which a sender may communication with a plurality of recipients).

8. Regarding claim 3, AAPA disclosed the limitations, substantially as claimed, as described in claim 2, including establishing a plurality of reciprocity rules (AAPA, Spec, page 2, AAPA admitted the types of networks admitted require reciprocity in transmissions).

9. Regarding claims 4 and 14, AAPA disclosed the limitations, substantially as claimed, as described in claims 1 and 9, including wherein said identifying further comprises: selecting said participant from an address book (AAPA, Spec, page 2, AAPA admitted senders of America Online selecting from a Buddy List).

10. Regarding claim 6, 8, 10, 12, 16, and 18, AAPA disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 15. The issues left out of AAPA are the reciprocity rule either preventing or permitting said participant from sending a response message to said originator and the ability to modify said reciprocity rule during said communication session. Examiner takes Official Notice (see MPEP § 2144.03) that "permitting or blocking recipients in responding to the originator as well as being able to modify the reciprocity rule during said communication" in an instant messaging environment was well known in the art at the time the invention was made.

11. It is suggested by Examiner that Applicant review the following related art: Davies et al. (U.S. Patent Number 6,853,634) in which Davies disclosed that users of the ICQ instant messaging system are able to control who contacts them and to hide their presence on the internet when required (Davies, col. 2, lines 40-45). This clearly

shows that the sender has the ability to permit or prevent recipients from responding as well as the sender being able to modify the rules during the communication when necessary.

12. Regarding claim 7, AAPA disclosed the limitations, substantially as claimed, as described in claim 1, including wherein said communication session is an Internet instant messenger session (AAPA, Spec, page 2, AAPA admitted America Online providing instant messenger services).

Response to Amendment

13. Applicant's arguments and amendments filed on 23 January 2006 with respect to claims 1-4, 6-10, 12-16, and 18-21 have been carefully considered but they are not deemed fully persuasive.

Regarding the 35 U.S.C. 101 rejection of claim 19, Applicant has failed to amend the claim in order to overcome the issue of non-tangible embodiments. Applicant is directed to the above rejection for reasoning as well as suggestions to make the appropriate changes.

Applicant's arguments include the failure of previously applied art to expressly disclose the teachings of a "reciprocity rule governing a communications session that is established by an originator" [see Applicant's Response, page 8, first paragraph].

However, Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP § 2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response, including a statement why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office action, i.e. "permitting or blocking recipients in responding to the originator as well as being able to modify the reciprocity rule during said communication", are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943) and MPEP § 2144.03, paragraph (C).

Applicant was suggested to review the following prior art for this limitation:

Davies et al. (U.S. Patent Number 6,853,634) in which Davies disclosed that users of the ICQ instant messaging system are able to control who contacts them and to hide their presence on the internet when required (Davies, col. 2, lines 40-45). This clearly shows that the sender has the ability to permit or prevent recipients from responding as well as the sender being able to modify the rules during the communication when necessary.

Applicant failed to provide any arguments regarding the Official Notice Taken, as well as failed to provide any arguments regarding how the claimed invention distinguishes over Davies.

As it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique.

By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bouchard et al. (U.S. 2005/0055411), a continuation of application No. 09/697,113, which includes a feature that allows instant messaging users to block other users from communicating with the user (Bouchard, paragraph 8.

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention. Examiner suggests Applicant to also review Examiner's Remarks in the previous office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

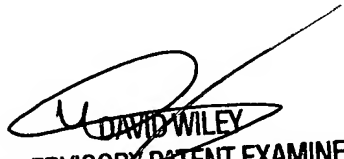
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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